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EXAMINER				
MOSSER, KATHLEEN MICHELLE				
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/712,938
Filing Date: November 13, 2003
Appellant(s): TIMBADIA ET AL.

Douglas H. Pearson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 7th, 2009 appealing from the Office action mailed January 7th, 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,565,316	Kershaw	10-1996
US PGPUB 2004/0229199	Ashley et al	11-2004

(9) Grounds of Rejection

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The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 13 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kershaw (US 5565316) in view of Ashley (US 2004/0229199).

Kershaw teaches a system including: one or more testing stations (Figure 1, element 3), configured to receive a plurality of test items, display the test items to a user (administering the test), record state information comprising time elapsed from the start of the examination, identification of the test items displayed to the user, and user interactions with the testing stations, and transmitting the state information (the examinee performance file, the content and use of which is described starting at col. 39: 48); a first server computer system in communication with the one or more testing stations, wherein the first server computer system is configured to electronically transmit the test items to the one or more testing stations, receive user information and responses to the test items from the one ore more testing stations and receive the state information from the one or more testing stations, and electronically store the state information at substantially the same time that the state information is received (Figure 3, element 2 and Figure 6); and a second server computer system in communication with the first server computer system, wherein the second server computer system is configured to receive user information and responses to the test items from the first server computer system and to deliver test packages to the first server computer system (figure 3 element 1 and Figure 4), as in claim 1.

With respect to claims 13 and 20, Kershaw further teaches the method of administering the examination including: synchronizing an initial state object on a server and one or more testing stations in communication with the server, wherein the initial state object comprises the time within which the examination must be completed and the test items to be presented to the user; delivering a plurality of test items to the one or more testing stations; displaying the plurality of testing items to the user and recording the user's responses and delivering to the server a changed state object comprising the time elapsed, the test items presented to the user, and the user's responses to the test items at substantially the same time that a triggering event occurs on the testing station, wherein the triggering event comprises the user providing a response to a test

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item, see the detailed description of the test delivery system starting in col. 30: 37 (note language taken from claim 13, but substantially similar features occur in claim 20 and can be found within the same citation). Further, upon the failure of the testing station, the initial state object and the changed state objects stored in the server are used to recreate the examination on the testing station at the point of the examination where the failure occurred (see figure 60), as in claims 1, 13 and 20.

Kershaw does not explicitly teach that the state information is transmitted at the same time that the state information is received (claims 1, 13, and 20) including when the user provides responses to the test items (claim 1) or that the user is not penalized for the time that questions are not available. Ashley teaches a computer based testing system with substantially similar computer architecture of Kershaw, which transmits student responses as they are entered by the student (paragraph 111). The system also includes several fault recovery scenarios (see the section starting at paragraph 122). It would have been obvious to one of ordinary skill in the art to include immediate transmission of the student's responses to the local repositories so as to ensure that the student's most recent testing information is available for immediate recovery should the student testing station fail. Ashley, like Kershaw fails to explicitly state that the student is not penalized for the time that questions are not available. The Applicant has admitted that such a feature is well known in the art of standardized testing. (Note admission was made through lack of adequately traversing the official notice made in the final rejection dated January 7th, 2009). Such a feature allows for compensations to the test taker should there be power failures, environmental failures (HVAC system, etc) or other significant interference with a test being administered. It would have been obvious to one of ordinary skill in the art to include such an assurance within the inventions of Kershaw and Ashley so as to ensure that the student is allowed to complete a test given the entirety of the time allotted for completion of the test.

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(10) Response to Argument

Appellant's arguments against the rejection of claims 1, 13 and 20 are directed to the same issues. As such, claim 1 is taken as an exemplary claim.

Section A. Appellant Asserts that the Denial of the Priority Claim to Provisional Application No. 60/425740 is Erroneous

As stated in the final action:

"Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 60/425740, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The prior application fails to adequately disclose the limitations of "upon failure of the testing station, the initial state object and the changed state objects stored on the server are used to recreate the examination on the testing station at the point in the examination where the failure occurred" and that "the user will not be penalized for the time that questions are not available", as recited in claims 1, 13, and 20. There is no mention of either of these features in the prior filed document. As such, the claim for priority does not comply with the conditions for receiving priority, and the claims are given a date commensurate with the filing of the instant application (November 13th, 2003). The examiner notes that these features were added to the pending claims in the amendment dated 10/24/2008."

The appellant has broken the clause asserted as not being enabled into 3 components:

- use of objects stored on the server to recreate the examination on the testing station at the point in the examination where the failure occurred
- the objects include an initial state object and changed state objects; and
- the user is not penalized for the time that questions are not available.

The examiner concurs that these are the three major elements of the limitation found not to be fully supported by the provisional application. Each element is taken in turn.

1. Recreation of the examination based upon stored test objects

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The examiner concurs with the appellant that the provisional application provides support for the reconstruction of an examination based upon state objects which are stored on the central server.

The examiner maintains that one of those objects being an "initial state object" is not taught, this is addressed in section 2.

2. The inclusion of both an initial and changed state object

To support the feature of an initial state object being stored and used in the recreation of the examination state the appellant relies upon page 10, line 26 to page 11, line 4 of the provisional application. The citation describes the first transmission of the test state from the testing station to the central server and depends on the potential situation where no new change of state has occurred including the absence of response data.

However, the specification of the instant invention as originally filed on November 13th, 2003 defines the initial state object as a substantially different element. Paragraph 7 of the specification as originally filed states:

"[0007] In an alternate embodiment of the invention, information regarding the status and state of the examination on the testing station is recorded on a memory device accessible by the central server for fault recovery purposes. The central server records an initial state for the testing station, which initial states is determinable by the central server given identification of the examination being taken. The initial state is embodied in a data object which is delivered to the testing station and stored in volatile memory, allowing the state to be maintained on the testing station and mirrored on the central server. Thereafter, the testing station delivers changes to the state, which may comprise interactions by the user with the testing station and elapsed time, to the central server periodically and upon the occurrence of certain user actions." [emphasis added]

Paragraph 32 further states in part:

"[0032] FIG. 2 illustrates the method for performing state management according to an embodiment of the invention. The method is initiated at the start of the test 205 on the testing station. The testing station transmits identification of the examination being administered to the service center 210. The service center then creates an initial state object for that examination 220 and stores the initial state object on a data storage device. The initial state object is delivered from the service center to the testing station 225. The state object includes identification of the examination being administered any may also comprise test items, test item response, lapsed time and any other information related to the taking of the examination." [emphasis added]

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As can be seen through both of the above citations, the initial state object of the instant invention is created at the central server and then transmitted to the testing station and includes specific information relating to the test being administered. The initial state object of the instant invention is clearly more than a basic transmission from the test station to the central server. It is instead the exact opposite, an initial state transmission from the central server to the testing station based upon the test to be administered. It is relevant to note, that both the appellant's citation and the examiner's citation reference Figure 2 of the provisional and non-provisional respectively. Significant modifications of this figure occurred between the provisional and the instant invention, as demonstrated below.

Figure 2 of the provisional application:

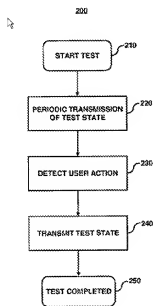
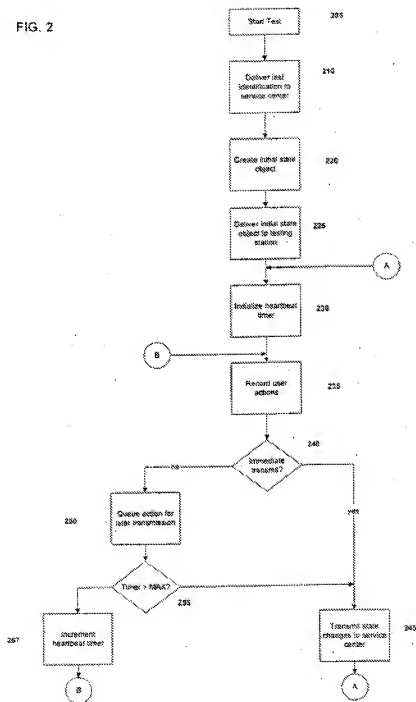


FIG. 2

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Figure 2 of the instant application:

FIG. 2



The instant application determines, at the central server, an initial state object based upon the test being administered at the testing station and transmits that initial object to the

testing station. Appellant's argued support for this element only described transmission of a state object from the testing station to the central sever, and fails wholly to mention the creation of such an object at the central server. The provisional application fails to provide any support for an object created at the central server and then transmitted to the testing station in the manner the initial state object is described in the instant application. Given these stark differences between the provisional application's description and that of the instant application, it is clear that the prior application does not disclose the concept of an initial state object in such a manner to demonstrate that the applicant had possession of the invention at the time of filing and does not disclose the feature of an initial state object in such a manner that one could make and use the invention, commensurate with the instant claims, without undue experimentation.

3. The user not being penalized for the time questions are not available

To support the recitation of "wherein the user will not be penalized for the time that questions are not available" the appellant cites the paragraph beginning on page 10 lines 13-19 of the provisional application. In this citation, the provisional describes that the elapsed time takes into account amount of time that a test is unavailable to the user and provides a specific example directed to transmission latency of examination questions. The requirements for 35 U.S.C. §112, 1st paragraph, require that the applicant show that the inventor had possession of the claimed invention at the time of the invention and that the description enables one of ordinary skill in the art to make and use the invention without undue experimentation. In the instant case, the appellant has only shown how the elapsed time variable could be used to not penalize the student for questions being unavailable during the transmission of such questions to a user. The specification of the provisional application does not show the appellant contemplated the use of this variable in the recovery functions of the invention. The provisional application only demonstrates a broad ranging concept and does not demonstrate that the appellant had contemplated the use of the elapsed time variable to not penalize students for the questions being unavailable during the fault recovery process. The broad description that "any time" that the questions are unavailable could potentially cover any conceivable scenario, both those known

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and unknown to the inventor, and does not portray that the appellant had possession of the invention (the use of the elapsed time variable to not penalize the student during fault recovery scenarios) at the time the invention was filed.

B. Ashley's availability as prior art

As shown above, the provisional application does not described the invention in the manner required by 35 USC §112, 1st paragraph. Therefore, the priority date of the provisional application should not be granted and the Ashley reference qualifies as under 35 USC §102(e). As such, a rejection based upon such should be maintained.

C. Ashley's teaching of transmitting changed to state information at the same time that the user provides responses

Appellant asserts that Ashley fails to teach the feature of transmitting changes to state information at the same time that the state information is recorded, including when the user provides responses to the test items. In arguing this feature the appellant has only argued the Ashley reference and wholly disregards the teachings of the Kershaw reference. Kershaw teaches in col. 39: 49-57:

"During the testing session, the test delivery application generates log records which are recorded in an examinee performance file. The examinee performance file is the outside world link to what happened during the examinee's testing session. One performance file is generated for each test session. The performance file is created when the administrative application initiates the examinee sign-on procedure. Each system event thereafter causes a log record to be created and written to the performance file."

This citation of Kershaw teaches the writing of a log at each system event. These events include the student making a selection of a response to a test item, as it is described in col. 39: line 35 and the description of "End Item" events and further described in col. 42: 8-26. As can be seen in these citations the invention of Kershaw updates the state of the test for each event, including student responses, at the same time the responses are entered. Kershaw however, does not transmit these changes of state to the central server whenever they occur. Instead the changes are stored in the local memory of the testing station. Ashley teaches in paragraph 111, as that any time information concerning the test is stored to the local disk it is simultaneously

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passed to the local server. The Ashley reference is only relied upon for the simultaneous transmission of data to a central server with the writing of such data to the local disk. As shown in the rejection above, the combination of Kershaw and Ashley teaches the limitation of transmitting changes to state information at the same time that the state information is recorded, including when the user provides responses to the test items.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Kathleen Mosser/

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